

REMARKS

I. Status Of Claims

Claims 17-32 are pending. Claims 17-19, 21, 24, 28-29, and 32 are currently amended. Claims 17-32 were rejected. Claim 33 is canceled.

Claim 17 is currently amended to read: "a first compound in an effective amount of for treating alopecia or promoting hair growth, wherein said first compound is a nitrogen-containing heterocyclic compound having two or more heteroatoms."

Claims 17-19, 21, 24, 28-and 29 are currently amended to add the term "first."

Claims 17, 24, and 32 are amended to correct obvious inadvertent typographical errors whose solutions would have been obvious, i.e., "~~with-a~~ with an" (claim 17), "~~is-a~~ is an" (claim 24), and "~~C₃-C₉ cycloalkyl~~ cycloalkyl" (claim 32).

II. Issues From The Appeal

There were four issues presented for appeal:

A. whether claim 33 is patentable under 35 U.S.C. § 102(b) over U.S. Patent 5,801,187;

B. whether claim 33 is patentable under 35 U.S.C. § 102(b) over U.S. Patent 6,200,972;

C. whether claim 33 is patentable under 35 U.S.C. § 102(b) over U.S. Patent 6,218,544; and

D. whether claims 17-32 are patentable under the judicially created doctrine of obviousness-type double patenting over claims 5-6 and 8 of copending U.S. Application No. 09/784,174.

Issues A-C were decided in favor of the Examiner's rejection.

Issue D was remanded for the Examiner's consideration.

New issue E—the 35 U.S.C. § 112, second paragraph rejection—was raised on appeal.

III. Response To Issues A-C

The rejection of Issues A-C should be withdrawn, as claim 33 is canceled.

IV. Response To Issue D

The Examiner urged that claims 17-32 of the present application are a prima facie obvious variation of claims 5-6 and 8 of the '174 application. Office Action at 3-5. As the rejection is provisional, Office Action at 5, the Examiner is asked to withdraw this provisional rejection and to allow this application to issue, because it is believed that this response places the case in condition for allowance.

V. Response To Issue E

Claims 17-32 were rejected, because claim 17 recites "an effective" and "a second compound for treating alopecia or promoting hair growth," and because (a) it is unclear if an effective amount of a compound for treating alopecia or promoting hair growth is required and (b) it is unclear if the second compound is provided in an effective amount, and (c) there is no antecedent basis in the claim for the recitation "a compound for treating alopecia or promoting hair growth." Office Action at 2. Each issue (a)-(c) is addressed as enumerated:

Issue (a) is believed avoided by the present version of claim 17. Thus, this ground for rejection should be withdrawn.

Issue (b) is not really an indefiniteness issue. But the plain meaning of the language embraces a second compound that may or may not be present in an effective amount. Thus, this ground for rejection should be withdrawn.

Issue (c) is addressed by adding the term "first" in claims 17-19, 21, 24, and 28-29. Thus, this ground for rejection should be withdrawn.

CONCLUSION

Each rejection should be withdrawn and the application allowed.

It is submitted that the present application is now in condition for allowance. Favorable reexamination reconsideration of the application as amended are respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees; and applicant(s) hereby petition for any needed extension of time.